

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES



On Appeal to the Board of
Appeals and Interferences

Applicant(s) : Hari Kalva et al. Examiner: Beatriz Prieto
Serial No. : 09/240,509 Art Unit: 2152
Filed : January 29, 1999
For : CONTROL MESSAGE TECHNIQUE FOR USER INTERACTION
IN A TELECOMMUNICATIONS NETWORK

REPLY BRIEF

I hereby certify that this paper is being deposited with the United States
Postal Service as first class mail in an envelope addressed to:

Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-
1450

December 20, 2004

Date of Deposit

Paul A. Ragusa

Attorney Name

38,587

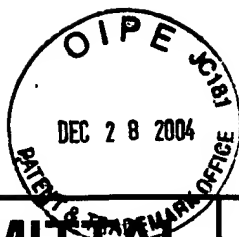
Registration No.


Signature

December 20, 2004

Date of Signature

BAKER BOTTS LLP



FEE TRANSMITTAL for FY 2004

Effective 10/01/2003. Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT

(\$)**0**

Complete if Known

| | |
|----------------------|------------------------|
| Application Number | 09/240,509 |
| Filing Date | Jan. 29, 1999 |
| First Named Inventor | Hari Kalva, et al. |
| Examiner Name | P. Beatriz |
| Art Unit | 2152 |
| Attorney Docket No. | AP 31569 (070050.0957) |

METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None

☒ Deposit Account:

 Deposit
Account
Number
Deposit
Account
Name

02-4377

Baker Botts LLP

The Commissioner is authorized to: (check all that apply)

☐ Charge fee(s) indicated below ☐ Credit any overpayments

☒ Charge any additional fee required under 37CFR 1.16 and 1.17

☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

FEE CALCULATION

1. BASIC FILING FEE

| Large Entity | | Small Entity | | Fee Description | Fee Paid |
|--------------|----------|--------------|----------|------------------------|---------------|
| Fee Code | Fee (\$) | Fee Code | Fee (\$) | | |
| 1001 | 770 | 2001 | 385 | Utility filing fee | |
| 1002 | 340 | 2002 | 170 | Design filing fee | |
| 1003 | 530 | 2003 | 265 | Plant filing fee | |
| 1004 | 770 | 2004 | 385 | Reissue filing fee | |
| 1005 | 160 | 2005 | 80 | Provisional filing fee | |
| SUBTOTAL (1) | | | | | (\$) 0 |

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

| Total Claims | Extra Claims | Fee from below | Fee Paid |
|--------------------|--------------|----------------|----------|
| 20 | 0 | | 0 |
| Independent Claims | 3 | 0 | 0 |
| Multiple Dependent | | | |

| Large Entity | | Small Entity | | Fee Description |
|--------------|----------|--------------|----------|--|
| Fee Code | Fee (\$) | Fee Code | Fee (\$) | |
| 1202 | 18 | 2202 | 9 | Claims in excess of 20 |
| 1201 | 86 | 2201 | 43 | Independent claims in excess of 3 |
| 1203 | 290 | 2203 | 145 | Multiple dependent claim, if not paid |
| 1204 | 86 | 2204 | 43 | ** Reissue independent claims over original patent |
| 1205 | 18 | 2205 | 9 | ** Reissue claims in excess of 20 and over original patent |

SUBTOTAL (2) (\$)**0**

**or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)

3. ADDITIONAL FEES

| Large Entity | | Small Entity | | Fee Description | Fee Paid |
|--------------|----------|--------------|----------|--|----------|
| Fee Code | Fee (\$) | Fee Code | Fee (\$) | | |
| 1051 | 130 | 2051 | 65 | Surcharge - late filing fee or oath | |
| 1052 | 50 | 2052 | 25 | Surcharge - late provisional filing fee or cover sheet | |
| 1053 | 130 | 1053 | 130 | Non-English specification | |
| 1812 | 2,520 | 1812 | 2,520 | For filing a request for <i>ex parte</i> reexamination | |
| 1804 | 920* | 1804 | 920* | Requesting publication of SIR prior to Examiner action | |
| 1805 | 1,840* | 1805 | 1,840* | Requesting publication of SIR after Examiner action | |
| 1251 | 110 | 2251 | 55 | Extension for reply within first month | |
| 1252 | 420 | 2252 | 210 | Extension for reply within second month | |
| 1253 | 950 | 2253 | 475 | Extension for reply within third month | |
| 1254 | 1,480 | 2254 | 740 | Extension for reply within fourth month | |
| 1255 | 2,010 | 2255 | 1,005 | Extension for reply within fifth month | |
| 1401 | 330 | 2401 | 165 | Notice of Appeal | |
| 1402 | 330 | 2402 | 165 | Filing a brief in support of an appeal | |
| 1403 | 290 | 2403 | 145 | Request for oral hearing | |
| 1451 | 1,510 | 1451 | 1,510 | Petition to institute a public use proceeding | |
| 1452 | 110 | 2452 | 55 | Petition to revive - unavoidable | |
| 1453 | 1,300 | 2453 | 650 | Petition to revive - unintentional | |
| 1501 | 1,330 | 2501 | 665 | Utility issue fee (or reissue) | |
| 1502 | 480 | 2502 | 240 | Design issue fee | |
| 1503 | 630 | 2503 | 315 | Plant issue fee | |
| 1460 | 130 | 1460 | 130 | Petitions to the Commissioner | |
| 1807 | 50 | 1807 | 50 | Processing fee under 37 CFR 1.17(q) | |
| 1806 | 180 | 1806 | 180 | Submission of Information Disclosure Stmt | |
| 8021 | 40 | 8021 | 40 | Recording each patent assignment per property (times number of properties) | |
| 1809 | 770 | 2809 | 385 | Filing a submission after final rejection (37 CFR 1.129(a)) | |
| 1810 | 770 | 2810 | 385 | For each additional invention to be examined (37 CFR 1.129(b)) | |
| 1801 | 770 | 2801 | 385 | Request for Continued Examination (RCE) | |
| 1802 | 900 | 1802 | 900 | Request for expedited examination of a design application | |

Other fee (specify)

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$)**0**

SUBMITTED BY

Name (Print/Type)

Paul A. Ragusa

Registration No.
(Attorney/Agent)

38,587

(Complete if applicable)

Telephone 212-408-2588

Signature

Date

12/20/04



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

**On Appeal to the Board of
Appeals and Interferences**

Appellant(s) : Hari Kalva et al.

Examiner: Beatriz Prieto

Serial No. : 09/240,509

Art Unit: 2152

Filed : January 29, 1999

For : CONTROL MESSAGE TECHNIQUE FOR USER INTERACTION
IN A TELECOMMUNICATIONS NETWORK

REPLY BRIEF ON APPEAL

On June 30, 2004, Appellant filed an Appeal Brief in the above-identified patent application opposing the final rejection of claims 1-14 memorialized in the Final Official Action issued by the U.S. Patent and Trademark Office (the “PTO”) on July 7, 2003. An Examiner Answer was mailed on October 21, 2004. In response thereto and in accordance with 37 C.F.R. § 41.41, Appellant submits this brief in support of the appeal of the final rejection of pending claims 1-14. For the reasons set forth below, in addition to the reasons set forth in Appellant’s June 30, 2004 Appeal Brief, the final rejection of pending claims 1-14 should be reversed.

I. Appellant's Response to Section (10) - Grounds of Rejection

As discussed in more detail in Appellant's Appeal Brief, Appellant's invention, as recited in independent claim 1, is a method for communicating command information between a server and a client across a network in an interactive communication system which comprises, *inter alia*:

- (a) generating a command message including a command, a command descriptor, and one of a server route for directly associating a node with the command descriptor and a command node for indirectly associating a node with the command descriptor; and
- (b) transmitting the command message across a network upon occurrence of a triggering event.

As in the Final Office Action, the Examiner's positions set forth in the Examiner's Answer are based on the cited Woods and Coven references, which relate to the VRML specification and specifically to VRML 2.0. However, the VRML techniques described in the references are acknowledged in the present application, Background of the Invention, as defining the state of the art at the time the present application was filed. These cited VRML techniques fail to address the problems to which the claimed invention are directed.

For example, the importance of a back channel and client-server communications in MPEG-4 systems is highlighted in the present application. As set forth in the Background of the Invention, "[i]nteractivity is a prominent concern in the development of the MPEG-4 international standard. A back channel is specified for interactive message support. However, the syntax and semantics of the messages to be carried through that channel remain unspecified, and so does the mechanism that triggers the transmission of such messages." (Specification, p. 1, Ins. 6-11.) Furthermore, as stated in the specification, "MPEG-4 essentially uses two modes of interactivity: local and remote. Local interactivity can be fully implemented using the native

event architecture of MPEG-4 BIFS (Binary Format for Scenes), which is based on the VRML 2.0 ROUTEs design.” (Specification, p. 1, lns. 26-29 (emphasis added)).

As clearly stated throughout the specification and elucidated by the claims, one of the objects of the invention is to provide *remote* interactivity between, e.g., client and server. Indeed, as acknowledged in the Background of the Invention of the specification, the VRML technologies which are the subject of the prior art relied upon by the Examiner can provide *local* interactivity, but that is *not* the subject of the claimed invention. In other words, as further stated in the Background of the Invention, “[t]he fact that MPEG-4 Systems already contains local interactive support via the use of event source/sink routes that are part of the scene description (BIFS) makes it desirable to have a server interaction process that fully integrates with the local interactivity model.” The described “server interaction process” is the subject of the claimed invention, and the “local interactivity model” is the subject of the cited prior art.

Accordingly, the VRML references, e.g. the Woods reference, which focuses on transmission of messages *locally* (i.e., on the same computer), necessarily fail to disclose or suggest at least “generating a command message including a command, a *command descriptor*, and one of a *server route* for directly associating a node with the command descriptor and a command node for indirectly associating a node with the command descriptor,” and “transmitting the command message *across a network* upon occurrence of a triggering event.”

These same arguments apply to all the claims of Group 1 (claims 1-7). For at least these additional reasons, Appellant respectfully requests that the Board reverse the Examiner’s rejection of claims 1-7 under 35 U.S.C. § 103(a) as being taught or suggested by Woods in view of Cohen.

Additionally, these same arguments apply to distinguish the system claim 8 over the Woods and Cohen references, and the rejection of claim 8 as obvious is also improper. *See C.R. Bard, Inc. v. M3 Sys. Inc.*, 157 F.3d 1340, 1352, 48 U.S.P.Q.2D 1225, 1232 (Fed.Cir.1998). The same arguments also apply to all claims of Group 2 (claims 8-14). Accordingly, at least for the reasons presented above, Appellant respectfully requests that the Board reverse the Examiner's rejection of claims 8-14 under 35 U.S.C. § 103(a) as being taught or suggested by Woods in view of Cohen.

II. Appellant's Response to Section (11) - Response to Arguments

Appellant disagrees with several of the statements in the Examiner's Answer.

First, it is asserted on p. 6 of the Examiner's Answer that:

“[i]n response to the above-mentioned argument, claims 1 and 8, have been carefully reviewed, however, it is not found where in these claims there is a recitation of; “*a command comprises information to be transmitted back to the server computer upon the occurrence of an associated event*”. There is further in claim 1, no recitation of “*a route which targets a command descriptor*”, as argued. Thereby, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies are not recited in the rejected claim 1 and 8. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims.”

Examiner's Answer, p. 6. (emphasis in original).

Appellant disagrees with the Examiner's arguments in this respect. While it is true that limitations from the specification are not read into the claims, the Examiner agrees that the claims are to be interpreted *in light of the specification*. As is clear from the specification, including all of the portions cited in Part I of this Reply Brief, the present invention is directed to client-server communications. Further, as clear from the plain language of claim 1, a command message is transmitted “across a network” upon occurrence of a triggering event. Based on the

claim's plain language, further supported by a reading of the claim in light of the specification, it is clear that the command of the claim comprises information to be transmitted back to a server computer upon occurrence of an associated event. Woods fails to disclose or suggest at least this limitation.

Furthermore, on p. 8 of the Examiner's Answer, it is noted that:

“(i) with respect to the claim's preamble, there is no recitation of a computer, i.e., a client computer nor a server computer in the claim, given the broadest reasonable interpretation in light (sic) of the specification (see MPEP 2111), the “server” and “client” elements of the claim language are not required to be computers, they as well may be interpreted as process entities, (ii) with respect to the claim's preamble intended use, i.e. a method for communication command information between a server and a client across a network in an interactive communication system, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art.” Examiner's Answer, p. 8 (emphasis in original).

Appellant respectfully disagrees with the Examiner's statements in this respect as well. As would be understood by one of ordinary skill in the art reading the claim in light of the specification, claim 1 is directed to client-server communication, as in communication between computers on a network. This is clear from the portions of the specification cited in Part 1 of this Reply Brief (e.g., p. 1, lines 6-11, 26-29, etc.), as well as from the text of claim 1 itself (which recites, *inter alia*, “transmitting the command message across a network,” clarifying that the claimed client and server are networked, separate computers). The Examiner's purported interpretation of the claim language is inconsistent with the stated objects of the invention and the plain language of the claim. Accordingly, for at least these additional reasons, Appellant respectfully requests that the Board reverse the Examiner's rejection of claims 1-7 under 35 U.S.C. § 103(a) as being taught or suggested by Woods in view of Cohen.

These same arguments apply to all the claims of Group 2 (claims 8-14). For at least these additional reasons, Appellant respectfully requests that the Board reverse the Examiner's rejection of claims 8-14 under 35 U.S.C. § 103(a) as being taught or suggested by Woods in view of Cohen.


III. Conclusion

For at least the reasons indicated above, in addition to all the reasons set forth in Appellant's Appeal Brief, Appellant respectfully submits that the invention recited in the claims of the present application, as discussed above, is new, non-obvious and useful. Reversal of the Examiner's rejections of the claims is therefore respectfully requested.

Respectfully submitted,

Dated: December 20, 2004

By:


Paul A. Ragusa
Patent Office Reg. No. 38,587

Attorneys for Appellant(s)
Baker Botts L.L.P.
30 Rockefeller Plaza
New York, NY 10112
Telephone: (212) 408-2500